Application No. 09/837,196
Amendment dated January 12, 2006
Reply to Office Action of July 12, 2005

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REMARKS

The Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-10 are pending. Claims 1, 4, 7, and 10 are independent. None of the claims have been amended. The Examiner is respectfully requested to reconsider the rejections in view of the remarks set forth herein.

Claim for Priority

The Examiner has acknowledged the Applicants' claim for foreign priority.

Drawings

It is gratefully appreciated that the Examiner has accepted the drawings.

Rejection Under 35 U.S.C. § 102(e)

Claims 1-10 stand rejected under 35 U.S.C. § 102(e), as being anticipated by Yamada et al. This rejection is respectfully traversed.

In response, the Applicants respectfully submit that each of independent claims as originally filed sets forth a novel combination of features not taught or suggested by the references cited by the Examiner, including Yamada et al.

As set forth in each of independent claims 1, 4, 7, and 10, the present invention includes, *inter alia,* "attaching thumbnail images of said representative images to the surface of said storage medium disk".

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Support for the novel combination of features in claims 1, 4, 7, and 10, can be found in the specification, for example, on pages 3 and 4. For example, beginning on page 3, line 16, the specification discloses "the expression 'attached to the surface of the storage medium disk' refers to, for example, not only a thumbnail image of a representative image directly printed onto the surface of the storage medium disk, but also includes the sticking of a representative image printed out as a sticker, etc. onto the surface of the storage medium disk, or any other method providing for recognition of the representative images on the surface of the storage medium disk".

In addition, beginning on page 4, line 13, the specification discloses, "the surface of the storage medium disk" includes the physical region of recording on a storage medium and the support body thereof". Further support for the presently claimed subject matter can be found in FIG. 1 of the present application, which shows thumbnail image 9 attached to the surface 8 of the storage medium 7.

By contrast, as can be seen in Yamada et al. paragraphs [0009] to [0012], this document merely discloses storing the encoded data of the thumbnail images of the representative images in the storage medium. Further, as can be seen in the Yamada et al. FIGS. 4-15, this document merely discloses how data is encoded and show the encoded data is stored in the storage medium.

Nowhere in Yamada et al. is there any hint of "attaching thumbnail images of said representative images to the surface of said storage medium disk", as presently claimed.

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At least for the reasons set forth above, the Applicants respectfully submit that the references cited by the Examiner, including Yamada et al., fail to teach or suggest the combination of novel features set forth in any of independent claims 1, 4, 7, and 10. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested. Independent claims 1, 4, 7, and 10, and the claims depending therefrom are in condition for allowance.

Rejection Under 35 U.S.C. § 101

Claim 10 stands rejected under 35 U.S.C. § 101 as allegedly being directed to a recording medium storing non functional descriptive material. The Examiner proceeds to state "Data structures not claimed ....are descriptive material per se and are not statutory....". This rejection is respectfully traversed.

The Applicants respectfully submit that independent claim 10 as originally filed sets forth "A storage medium for recording some or all of plural sets of image data, wherein index images of the representative images of the images represented by said plural sets of image data are attached to the surface of the storage medium disk". As such, independent claim 10 properly sets forth the structural relationship among a combination of elements comprising the storage medium. Support for the novel combination of features set forth in claim 10 can be found for example, on pages 3 and 4 of the specification, and in FIG. 1.

Independent claim 10 does not, as the Examiner alleges, set forth a data structure of any sort.

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Therefore, the Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 101 is not proper and should be withdrawn.

Claims 1-10 of the present application are in condition for allowance.

CONCLUSION

Since the remaining patents cited by the Examiner have not been utilized to reject claims, but merely to show the state of the art, no comment need be made with respect thereto.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee of $1020 is attached hereto.
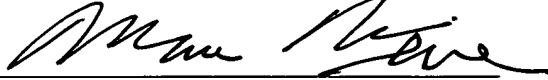
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen, Registration No 50,786, at (703) 205-8000.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future

replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for

any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time

fees.

Respectfully submitted,
BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

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MSW/CTT/ags